

#22

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Tucholski

FYI

Serial No.: 641,394

Filed: January 15, 1991

SEP 17 1993

For: PROCESS FOR BATTERY TESTER

RECEIVED IN
BOX INTERFERENCE

Commissioner of Patents and Trademarks
Attention: Ian A. Calvert, Vice Chairman
Board of Patent Appeals and Interferences
Box Interference
Washington, D.C. 20231

RESPONSE TO OBJECTION FOR ACCESS

The applicant has filed an Objection to the Petition for Access filed by the undersigned. The applicant provided the undersigned with a copy of the application to which access is sought but did not provide a copy of the prosecution. The basis for the refusal to provide the prosecution is that "no prosecution has taken place in this application of the subject matter claimed in U.S. Patent 5,223,003.

The undersigned respectfully submits that the basis for the objection to the prosecution filed by the applicant is improper and it is respectfully requested that access be granted to the prosecution.

Applicant has argued that:

"(E)ach of the claims of the patent specifically recites the step of applying 'a layer having a color contrasting to the color of the thermally sensitive material between the conductive layer and thermally sensitive material'",

and that

"(T)his step was the subject matter added in the continuation-in-part application."

The statements quoted above support the undersigned's position that access to the prosecution of the patent application is warranted.

The use of a layer having a color contrasting to the color of the thermally sensitive material positioned between the conductive layer and the thermally sensitive material was well known in the art more than a year prior to the filing date of the CIP application. Attached hereto as Exhibit A are U.S. Patents 4,723,656 and 4,835,475 which both disclose the color contrasting layer of step (c). U.S. Patent 4,723,656 discloses in col. 4, lines 1-11 a battery tester comprising conductive layer 24, thermally sensitive material 31, and scale layer 32 between layers 24 and 31. In col. 3, lines 1-11 and col. 7, lines 34-43 the operation is described wherein a thermal response results in the layer 31 changing color to reveal the scale layer 32. The scale layer 32 must of course be a different color than the thermally sensitive material in order to read the scale.

U.S. Patent 4,835,475 also discloses a battery tester of the type described and claimed in the Tucholski et al. patent. Figures 9 and 10 show a battery tester having in succession a conductive layer 123, a non-thermochromic layer 125 and a thermochromic layer 127. (See col. 8, line 65 through col. 9, line 2). The operation is described in col. 10, lines

19-25 where it is stated that the color difference between layers 125 and 127 can be amplified.

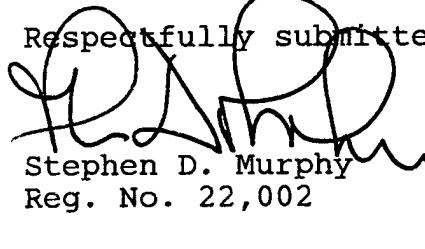
Accordingly, the patent claims could not possibly have been allowed on the basis of this subject matter which, by patentee's own admission, constitutes the only subject matter that was first presented in the CIP case. Therefore, the allowance necessarily was based upon considerations which can only be understood from the analysis of the prosecution of the parent application. Thus, access to the prosecution of this application should be permitted.

Moreover, the applicant contends that there are no claims in the application comparable in scope to the claims of the patent because none of the claims in the application include the feature of a layer having a color contrasting to the color of the thermally sensitive material and for this reason access to the prosecution should be denied.

Applicant's objection, however, misses the point of MPEP §103 which states that prosecution in the earlier application of subject matter claimed in the patent must be disclosed. Thus, prosecution that is solely related to step (c) of claim 1 of the patent could be withheld but that is all that can be withheld. Prosecution that relates to one or more of the other features of claim 1, specifically paragraphs (a), (b) and (d), must be disclosed. Thus, any portion of the prosecution relating to a conductive layer having first and second terminal contact ends that are electrically connected to each other via

an area of controlled resistivity must be disclosed. In addition, any prosecution relating to a thermally sensitive material in thermally sensitive contact with the area of controlled resistivity must be disclosed. Furthermore, any prosecution regarding a conductive layer disposed in relation to the terminals of the battery to complete a circuit to achieve a thermal response in the thermally responsive material must be disclosed. These above three features set forth in elements (a), (b) and (d) of claim 1 are subject matter that is claimed in the patent and any prosecution relating to those features must be disclosed. Likewise, any prosecution regarding the elements of dependent claims 2, 3, 4 and 5 must also be disclosed. This includes any prosecution regarding the thermally responsive material being a thermochromic ink.

In view of the above, it is respectfully requested that access be granted to the entirety of the prosecution of the above-referenced application.

Respectfully submitted,

Stephen D. Murphy
Reg. No. 22,002

Scully, Scott, Murphy & Presser
400 Garden City Plaza
Garden City, NY 11530
(516) 742-4343

PJE/emd

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Tucholski

Serial No.: 641,394

FYI

Filed: January 15, 1991

SEP 17 1993

For: PROCESS FOR BATTERY TESTER

RECEIVED IN
BOX INTERFERENCE

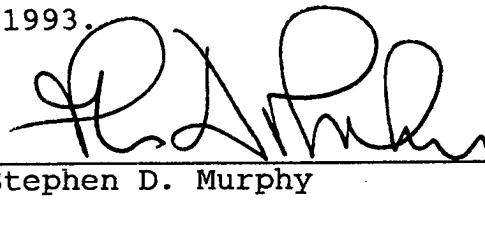
Commissioner of Patents and Trademarks
Attention: Ian A. Calvert, Vice Chairman
Board of Patent Appeals and Interferences
Box Interference
Washington, D.C. 20231

CERTIFICATE OF MAILING

This certifies that the attached RESPONSE TO OBJECTION
FOR ACCESS and accompanying exhibits are being deposited with
the United States Postal Service as first class mail in an
envelope addressed to:

Commissioner of Patents and Trademarks
Attention: Ian A. Calvert, Vice Chairman
Board of Patent Appeals and Interferences
Box Interference
Washington, D.C. 20231

this 15th day of September, 1993.


Stephen D. Murphy

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Tucholski

Serial No.: 641,394

Filed: January 15, 1991

For: PROCESS FOR BATTERY TESTER

FYI
SEP 17 1993

RECEIVED IN
BOX INTERFERENCE

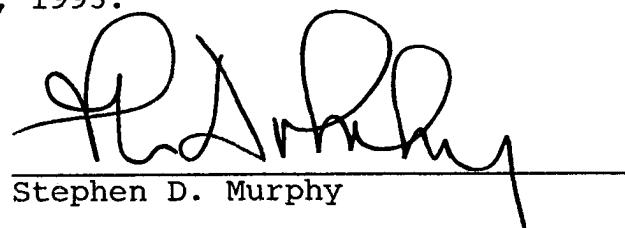
Commissioner of Patents and Trademarks
Attention: Ian A. Calvert, Vice Chairman
Board of Patent Appeals and Interferences
Box Interference
Washington, D.C. 20231

CERTIFICATE OF SERVICE

This certifies that a copy of the foregoing RESPONSE TO
OBJECTION FOR ACCESS and accompanying exhibits were served on:

Randall G. Litton, Esq.
Price, Heneveld, Cooper, DeWitt & Litton
695 Kenmoor, S.E., Post Office Box 2567
Grand Rapids, Michigan 49501

by mailing a copy thereof via first class mail, postage prepaid,
this 15th day of September, 1993.



Stephen D. Murphy